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10/763,484	01/23/2004	Nausheen Moulana	MWS-107RCE3	7031

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EXAMINER	
ZEE, EDWARD	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/763,484	MOULANA ET AL.	
	Examiner	Art Unit	
	EDWARD ZEE	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10 and 12-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10 and 12-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the amendments filed on 07/29/10. Claims 1, 10, 18 and 21-24 have been amended; and Claims 1-8, 10 and 12-24 are still pending and have been considered below.

Claim Objections

2. The amendments and/or arguments filed on 07/29/10 have been considered and are persuasive, and thus the previous claim objection(s) have been withdrawn.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-8, 10 and 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inokuchi et al. (2004/0133523) in view of Miles (2005/0223240).

Claim 1 and 21: Inokuchi et al. discloses a method of preventing use of an unauthorized copy of a software program residing on an optical medium, the method comprising:

a. providing a protection program*(ie. determining program)*, the protection program residing with the software program*(ie. software)*, the protection program:

i. searching for a file on the optical medium prior to determining a media type of the optical medium, the file containing the software program*(ie. in the case that the software such as a game or installer software contains such a determining*

program...therefore, the software containing the determining program must be executed before the determining can be conducted) [page 8, paragraph 0155];

ii. determining the media type of the optical medium containing the software program*(ie. determines whether the loaded disc is an original or a copied disc)* [page 8, paragraph 0155];

iii. and inhibiting execution of the software program stored on the optical medium if: the file is missing on the optical medium, or the optical medium has media type that indicates that the optical medium is copied*(ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted)* [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described "determining program" is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed*(...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...)* [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded*(...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...)* [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

Claims 2 and 3: Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of inhibiting the execution of the software program comprises preventing execution of selected features of the software program by determining a set of features of the software program to execute*(ie. selectively restrict only encrypted data, etc.)* [page 8, paragraph 0149].

Claim 4: Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of inhibiting the execution of the software program comprises preventing execution of the software program*(ie. operation is cancelled)* [page 8, paragraph 0149].

Claim 5: Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header of the optical medium*(ie. ATIP information such as writing characteristics, capacity, disc type, etc.)* [page 6, paragraph 0124].

Claim 6: Inokuchi et al. and Miles disclose the method as in claim 5, and Inokuchi et al. further discloses that the drive is a CD-R/W drive [page 2, paragraph 0029].

Claim 7: Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an erasable/rewriteable media type [page 6, paragraph 0124].

Claim 8: Inokuchi et al. and Miles disclose the method as in claim 1 above, and Inokuchi et al. further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [page 7, paragraph 0145].

Claims 18 and 23: Inokuchi et al. discloses a method of preventing execution of an unauthorized copy of a software program stored on an optical medium, the method comprising:

a. identifying a protection program*(ie. determining program)* residing on the optical medium with the software program*(ie. software)*, the protection program:

i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software program*(ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted)* [page 8, paragraph 0155];

ii. determining the media type of the optical medium*(ie. determines whether the loaded disc is an original or a copied disc)* [page 8, paragraph 0155];

iii. and executing the software program stored on the optical medium if: the file is included on the optical medium, and the optical medium has a media type that indicates

that the optical medium is an original version*(ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted)* [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described "determining program" is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed*(...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...)* [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded*(...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...)* [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

Claim 19: Inokuchi et al. and Miles disclose the method as in claim 18 above, and Inokuchi et al. further discloses that a read-only media type indicates that the optical medium is an original version [page 7, paragraph 0145].

Claim 20: Inokuchi et al. and Miles disclose the method as in claim 18 above, and Inokuchi et al. further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [page 7, paragraph 0132].

Claims 10 and 22: Inokuchi et al. discloses a method of authenticating an original optical medium, the method comprising:

a. accessing the optical medium in a compact disk-read/write (CD-R/W) drive coupled to a computer [page 2, paragraph 0029];

b. and identifying a protection program*(ie. determining program)* on an optical medium, the protection program:

i. searching for a file on the optical medium prior to checking a media type of the optical medium, the file containing a software program to be authenticated*(ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted)* [page 8, paragraph 0155];

ii. and checking the media type of the optical medium once the file has been located*(ie. determines whether the loaded disc is an original or a copied disc)* [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described "determining program" is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed*(...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...)* [page 8, paragraph 0154],

Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded*(...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first access the disc...this may be done automatically using an autorun function...)* [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

Claim 12: Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header of the optical medium*(ie. TOC)* [page 6, paragraph 0120].

Claims 13-15: Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses:

a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version [page 7, paragraph 0145];

b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [page 7, paragraph 0145].

Claim 16: Inokuchi et al. and Miles disclose the method as in claim 10 above, and Inokuchi et al. further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type [page 6, paragraph 0124].

Claim 17: Inokuchi et al. and Miles disclose the method as in claim 16 above, and Inokuchi et al. further discloses the step of inhibiting execution of a software program stored on the optical medium if the step of checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [page 7, paragraph 0132].

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inokuchi et al. (2004/0133523) in view of Miles (2005/0223240) and further in view of Bersson (6,081,897).

Claim 24: Inokuchi et al. discloses an electronic device comprising:

a. a memory for storing computer program instructions [page 2, paragraph 0029];

b. a processor for executing the stored computer program instructions [page 2, paragraph 0029];

c. and a compact disk-read/write (CD-R/W) drive for receiving an optical medium containing a software program*(ie. software)* and a protection program*(ie. determining program)*, the protection program including instructions for:

i. searching for a file on the optical medium containing the software program prior to determining a media type of the optical medium, the file containing the software

program*(ie. in the case that the software such as a game or installer software contains such a determining program...therefore, the software containing the determining program must be executed before the determining can be conducted)* [page 8, paragraph 0155];

ii. determining the media type of the optical medium*(ie. determines whether the loaded disc is an original or a copied disc)* and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium or the optical medium has media type that indicates that the optical medium is copied*(ie. when the disc is not an original disc, but a copied disc, access to the copied disc is restricted)* [page 8, paragraph 0155].

Nonetheless, while Inokuchi et al. strongly suggests that the described "determining program" is stored on the original disc along with the protect software and then loaded on to the computer when it is initially accessed*(...in the case that the software is a game which contains the determining program...when the disc is initially accessed...the determining program determines whether the loaded disc is an original or a copy...)* [page 8, paragraph 0154], Inokuchi et al. still does not explicitly state that the protection program first stored on the optical medium and later accessed from the optical medium itself.

However, Miles discloses a similar invention and further discloses an optical medium which stores a protection program, that is directly accessed from the optical medium each and every time the optical medium is loaded*(...preferably a disc produced according to the embodiment contains hidden software that is activated when the computer operating system first*

access the disc...this may be done automatically using an autorun function...) [page 3, paragraph 0048].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. with the additional features of Miles, in order to effectively detect/prevent unauthorized activities being performed by the computer, as suggested by Miles [page 4, paragraph 0060].

Furthermore, while Miles clearly discloses that the protection program*(supervisory program)* is built on the driver level*(inserts itself or part of itself into the operating system driver chain)* [figure 4b & page 3, paragraph 0048], Miles does not explicitly disclose that the driver level is particularly the ASPI layer.

Nonetheless, Bersson discloses a similar invention and further discloses building a protection program on the ASPI layer [column 3, lines 60-67 & column 4, lines 1-10].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the disclosure of Inokuchi et al. and Miles with the additional features of Bersson, in order to effectively intercept commands to the SCSI bus and thereby successfully inhibiting unauthorized actions, as suggested by Bersson [column 4, lines 60-67].

Response to Arguments

6. Examiner notes that attempts to contact Applicant's representatives were made on 08/11/10 and 08/12/10 in hopes of further clarifying Applicant's remarks and expediting prosecution, however no response has been received yet at this time.

7. Applicant's arguments with respect to **claim 24** have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 07/29/10 have been fully considered but they are not persuasive.

Regarding Claim 1: Applicants argue the prior art of record whether taken alone or in combination, still do not teach "searching, using the protection program *residing on the optical medium*, for a file on the optical medium prior to determining a media type of the optical medium, the file containing the software program", as recited in the instant claim(s). In particular, based on Applicants remarks (please see pages 8-10 of the remarks filed on 07/29/10), Applicants still appear to insist that the protection program of the claimed invention, operates directly from the optical medium and never enters the computer system memory, not even temporarily.

However, Examiner respectfully submits that Applicants own disclosure (please see page 7, lines 1-10 of the specification), clearly states that, "prior to running any application program...the program is loaded into RAM within memory and then executed by processor".

Therefore, Examiner respectfully disagrees and submits that the prior art of record does in fact fairly suggest the claimed protection program, as evident by Applicant's own disclosure, one of ordinary skill in the art would understand the claimed protection program to also be somehow loaded into the computer memory.

Examiner further notes that, if Applicant's intentions are to claim a protection *program* that does not load onto the computer system in order to execute, Applicants are kindly requested

to clarify how this is accomplished, as the specification clearly discloses *any program* must be first loaded before executing.

Regarding Claim 10: Applicants argue that the prior art of record whether taken alone or in combination, still do not teach "checking, using the protection program residing on the optical medium, the media type of the optical medium by examining *a mode parameter header of the optical medium* once the file has been located, the mode parameter header containing a media type code field", as recited in the instant claim(s). In particular, Applicants note that because Inokuchi discusses checking the TOC data, it is not equivalent to the mode parameter header, as the TOC data relates to the recording, and the mode parameter header relates to the media type.

However, Examiner respectfully submits that Inokuchi specifically discloses that the media type code field*("format field"...Format=0010, Format=0011, etc.)* determined in the TOC/PMA/ATIP area is related to the media type*(...when Format=0010...it is determined that the disc loaded into the drive is a reproduction-only disc...when Format=0011...it is determined that the disc is a CD-r or CD-RW...)* [page 6, paragraph 0127-0128 & page 8, paragraph 0154].

Therefore, Examiner respectfully disagrees and submits that the prior art of record does in fact disclose checking a media type code field equivalent to that which is recited in the claims, because while the media type code disclosed by Inokuchi may or may not also be related to the recording, it is still clearly related to the media type as well.

Furthermore, Applicants argue that, as taught by Inokuchi, the area from which the media type code field is determined is not explicitly called a "mode parameter header" area. In particular, it might appear that Applicants are suggesting the "mode parameter header" as

claimed, requires it to conform to industry standards as specified in the SCSI-2 specification (please see page 8, lines 20-30 of Applicant's own specification).

However, Examiner respectfully disagrees and submits that a generic labeling of the area as the "mode parameter header" does not absolutely require the area to conform to industry standards in terms of location and/or content formatting, as the specification appears to describe *exemplary* embodiments.

Thus, under the broadest reasonable interpretation, the prior art of record does in fact sufficiently disclose the claimed invention, as Inokuchi clearly teaches an area that functions equivalently to the claimed "mode parameter header" area.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Inokuchi et al. (5,745,459) discloses an optical media containing a TOC/PMA area which is explicitly called a "mode parameter header", having a media type code field similar to that of the claimed invention [table 5 & table 8a & column 12, lines 10-15].

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD ZEE whose telephone number is (571)270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. Z./
Examiner, Art Unit 2435
/Kimyen Vu/
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